

REMARKS

This is a response to the Official Action dated February 3, 2004 and the Advisory Action dated May 25, 2004. This Response is being filed concurrently with a Request for Continued Examination (RCE) and a request for a two-month extension of time up to and including July 6, 2004 (Monday, July 5, 2004 was a Federal holiday).

Claims 1-18 are pending in the application. Claim 1 has been amended, without prejudice. No claims have been added or canceled in this response. Reconsideration of the present application in view of the following remarks, and a notice of allowance on all pending claims are respectfully requested.

Summary of the Invention

The present invention, as defined by the claims, refers to the use of specific invert soaps that include at least one branched alkyl selected from nonyl, dodecyl, and tridecyl. Applicant has found that these specific invert soaps show a microbicidal effect, as well as a cleansing effect. The microbicidal effect of these compounds is such that they are effective against bacteria, fungi, and viruses and even against spores, all without an additional compound such as imidazoline or 2-bromo-2-nitropropane-1,3-diol. Additionally, these compounds have been found not to foam, which make them especially suitable for application to confined lumina, such as in endoscopes, as now claimed.

Interviews

Applicant wishes to note that an Interview Summary was received from the Examiner indicating that an interview was held with the undersigned on May 24, 2004. Applicant wishes to note that Applicant's representative telephoned the Examiner after receiving this interview summary. The purpose of the call was to question why the interview summary was issued since the only communication between the Examiner and Applicant's representative on May 24, 2004 was a voicemail message that was left by the Examiner indicating that an Advisory Action was being issued for this case. The Examiner explained that it was necessary to document the voicemail message in the event the Advisory Action was not timely issued by the Patent Office.

Applicant also wishes to thank the Examiner for the telephonic interview held on June 23, 2004. During that interview the scope of the then-pending claims was discussed. Applicant's representative reiterated Applicant's position that the then-pending claims were not obvious in view of the cited prior art. In the interest of facilitating prosecution, however, Applicant's representative indicated that Applicant would consider amending the term "comprising" to "consisting of" in independent claim 1. The Examiner indicated that such an amendment would likely overcome the prior art of record, but that additional searching may be necessary.

In this response, Applicant has amended independent claim 1 consistent with what was discussed during the interview on June 23, 2004. Applicant respectfully submits that the claims overcome the cited prior art as discussed in more detail below.

Rejections under 35 U.S.C. § 103(a)

Parker in view of Hall

Claims 1-18 were rejected in the February 3, 2004 Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,425,815 to Parker et al. ("Parker") in view of U.S. Patent No. 5,547,990 to Hall ("Hall").

Applicant respectfully submits that the claimed method would not have been obvious to one of ordinary skill in the art viewing any of the cited prior art. Parker discloses a multi-step process for cleansing and disinfecting endoscopic medical instruments that includes a first step whereby the instruments are subjected to a cleaning procedure (*see* Parker at col. 1, lines 23-27). This step is *not* described as comprising the use of quaternary ammonium compounds. In the second step described in Parker, the disinfection is typically performed with hyperchlorite (*see id.* at col. 1, lines 27-29; col. 4, lines 26-30). Alternatively, an unspecified quaternary ammonium compound may be used, which is described to be "a less powerful disinfectant" (*id.* at col. 1, lines 50-52).

There is no teaching in Parker of using a quaternary ammonium compound as a cleaning agent such that the multi-step process taught in that reference might be eliminated. In other words, there is a cleaning step *and* a separate disinfecting step in Parker that is accomplished with a different compound in each step. As such, Parker cannot anticipate or render obvious Applicant's claims.

Hall fails to remedy the foregoing deficiencies in Parker. Hall discloses a sanitizing and disinfectant solution comprising a quaternary ammonium compound and an amphoteric imidazoline derivative. According to Hall, “the unexpected discovery [is] that the *combination* of (1) certain substituted imidazoline based amphoterics with (2) quaternary ammonium compounds produce concentrates that have reduced ocular irritation, exhibit efficient cleaning and wetting and, most importantly, are biocidally active” (Hall at col. 2, line 63 – col. 3, line 1; emphasis added). There is no teaching in Hall that the specific ammonium compounds are capable of both cleaning *and* disinfecting without the aid of certain substituted imidazoline based amphoterics. The Examiner has failed to point to any teaching or suggestion in Hall of using any quaternary ammonium compounds alone.

According to the foregoing teachings, one of ordinary skill in the art would not have found it obvious to employ the quaternary ammonium compounds of Hall with the method of Parker. Hall teaches that it is the *combination* of certain substituted imidazoline based amphoterics *with* quaternary ammonium compounds that produces the improved result. Thus, Hall specifically *teaches away* from the Applicant’s claimed invention in that the reference teaches that a combination of quaternary ammonium compounds *plus* imidazoline compounds produces superior microbicidal activity as compared to the quaternary compound alone (*see* Hall at col. 3, lines 1-3). Furthermore, Parker teaches that unspecified quaternary ammonium compounds may be used only for disinfection, but the reference also notes that these compounds are “less powerful” disinfectants. Thus, Parker can also be said to *teach away* from the use of quaternary ammonium compounds as a disinfectant.

Thus, Applicant respectfully submits that the cited art provides no teaching or suggestion of Applicant’s claimed method and, in fact, the prior art teaches away from the claimed invention. Accordingly, Applicant respectfully submits that the claims clearly define over Parker and Hall.

O’Connor

Claims 1-5, 7, 8, 10, and 11 were previously rejected in the February 3, 2004 Office Action under 35 U.S.C. § 103(a) as being unpatentable over O’Connor et al. (Abstract of “Disinfection of gastrointestinal fibrescopes – evaluation of the disinfectants Dettol and Gigasept”). It appears that the rejection was also premised on Hall. This rejection does not

appear to have been discussed in the May 25, 2004 Advisory Action so it is unclear whether Applicant's previous arguments sufficiently overcame the rejection as to the then-pending claims. Nonetheless, Applicant will briefly reiterate why O'Connor does not anticipate or render obvious the invention as now claimed.

The February 3, 2004 Office Action states that "O'Connor et al. teaches the use of a quaternary ammonium compound to disinfect fibrescopes. Dettox is a proprietary composition and thus, the exact quaternary compound is unknown." As stated in a previous response, Applicant respectfully disagrees with the statement that "O'Connor et al. teaches the use of a quaternary ammonium compound." Dettox is alleged to be "based on a quaternary ammonium compound." There is no indication of what "based on" exactly means and thus, Applicant again submits that it is improper to automatically conclude that a quaternary ammonium compound is necessarily present in the product. Furthermore, even if such a compound is present, there is no indication of what quaternary ammonium compound it actually is. There is also no teaching in O'Connor et al. that a quaternary ammonium compound would be useful as *both* a disinfecting agent and a cleaning agent. O'Connor et al. only addresses the disinfecting ability of the two commercial compounds, the compositions of which are unknown.

Hall does nothing to remedy the deficiencies of O'Connor et al. As described previously, Hall discloses a sanitizing and disinfectant solution comprising a quaternary ammonium compound and an amphoteric imidazoline derivative. It is this *combination* that gives the desired result and there is no teaching in Hall that the specific ammonium compounds are capable of both cleaning *and* disinfecting without the aid of certain substituted imidazoline based amphoterics. Thus, it would not have been obvious to one of ordinary skill in the art to employ the compounds of Hall in the method of O'Connor et al. as the Office Action alleges and, accordingly, Applicant respectfully requests that this rejection be withdrawn.

For the foregoing reasons, Applicant respectfully requests that the pending rejections under 35 U.S.C. § 103(a) be withdrawn.

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PATENT

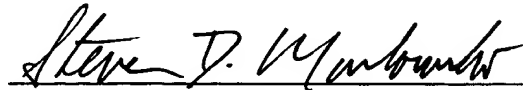
Application No.: 09/913,629

Office Actions Dated: February 3, 2004 and May 25, 2004

CONCLUSION

Applicant believes that the foregoing constitutes a complete and full response to the Office Action of record. Applicant respectfully requests allowance of claims 1-18.

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